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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,998	10/16/2003	Patrick J. Sweeney	029815-0103	7428
26371 7590 12/01/2009 FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306				
EXAMINER				
MILLER, CHERYL L				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
12/01/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,998

**Applicant(s)**

SWEENEY, PATRICK J.

**Examiner**

CHERYL MILLER

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 10, 12, 18, 22, 28, 37, 43, 66 and 70 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 5, 7, 9, 11, 13, 18, 21, 23, 27, 30, 61, 63, 68 and 69 is/are allowed.
- 6) ☒ Claim(s) 25, 32, 34, 38, 39 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5,7,9-13,18,21-23,25,27,28,30,32,34,37-39,41,43,61,63,66 and 68-70.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims do not further limit their independent claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 32, 34, 38, 39, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Malek (US 2005/0071007 A1, cited previously). See figures 25-28. Malek discloses a support shaft (240+232) having a first portion (232) slidably received (alternate to threaded connection is disclosed a saw tooth connection thus slidable, P0049, P0071; also in the threaded connection shown, the two cylinders slide helically with respect to one another), in a second portion (240), a locking ring (237) adapted to secure the first portion to the second portion (because lock ring has notches which correspond to other notches and tabs, the notch of lock ring 237 contributes to locking the portions relative one another; see fig.28), first prosthesis endplates (286 OR 242), an

artificial disc having a core (302 or 304) and disc endplate (270 or 272), the disc (270+302) coupled to the prosthesis endplate (286 or 242) by an interlocking structure (complimentary surfaces, concave/convex). Malek discloses a pedicle screw retainer (tab 268 or portion of baseplates, see P0054) for receiving a screw (270; fig.28) capable of extending through a pedicle. Malek discloses the endplate tray (when considered 242) screwed to the shaft (240+232). Malek discloses use with different disc prostheses (P0007, P0008). It is noted that the disc prostheses of claim 32 are not positively claimed, they are recited only as intended use (when implanted, method step) thus not required by the claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 34, 38, 39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buttermann (US 2005/0113924 A1, cited previously). Buttermann discloses the spinal prosthesis substantially as claimed. Buttermann discloses a spinal implant system (figs.15, 17, 21, 24) comprising a vertebral prosthesis (fixation member; 214 for example) comprising a support (224) with a first portion slidably received in a second portion (see figs) and prosthesis endplate (252), an artificial disc comprising a disc endplate (244) and disc core (242+240), the artificial disc interlocked with the prosthesis endplate (by recess and flange, morse taper connection), an a pedicle screw retainer (holes in fixation member; P0095; P0106) having top,

bottom and aperture (246, 510) for a screw (310) capable of penetrating a pedicle. Buttermann discloses different disc prosthesis by having different amounts of spring and spring constants (P0025, P0139). Buttermann discloses a locking ring for securing the first portion relative the second portion of the support (c-clamps, P0117, P0125).

Buttermann discloses the prosthesis endplate and support to be attached, however is silent to mention how they are connected. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of the claimed connections (threaded, snapped, or twisted), since such are common attachment means. It would be common sense to use any form of attachment, as Buttermann is silent to a specific attachment method.

***Allowable Subject Matter***

Claims 1,3,5,7,9,11,13,18,21,23,27,30,61,63,68 and 69 are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/  
Examiner, Art Unit 3738

/Corrine M McDermott/  
Supervisory Patent Examiner, Art Unit 3738